REMARKS

Claim Rejections – 35 U.S.C. §102

Claims 27-32 and 37-42 have been rejected under 35 U.S.C. §102(b) as being anticipated by Lehmus (WO 9833343). The rejection is respectfully traversed.

Lehmus discloses a subscriber identity module (SIM) that allows integration of different smart card functions with the SIM card using in a mobile station. A description of Lehmus follows, including problems associated using different types of card. Reference is made to the international publication for page and line numbers.

1) SIM card (p.1, l.10 – p.2, l.6 and p.2, l.23-32)

A SIM card includes at least one subscriber identity module which identifies the subscriber in a mobile network. The modules comprises an interface to a mobile station. Communication between the module and the mobile station is initiated by the mobile station. The module cannot initiate communication with the mobile station (p.1, l.10-18). It also includes the subscriber's international telephone number and other user-specific and network-specific data, such as the user's coded speed dialing numbers, a password to prevent misuse, and international codes of interconnected systems (p.1, l.26-32).

2) Smart card (p.2, l.7-22 and p.2, l.33 – p.3, l.10)

Smart cards are used for user identification or payment of services, e.g. as an access card, a key, as a bank card, or as a (remote-read) card in buses. A smart card comprises an interface to the external world, the world usually being a smart card reader. The interface is either a galvanic contact or a wireless connection. In the latter, both the smart card and the reader are provided with coils, between which both information and power needed for the function of the card are transferred (p.2, l.11-19). Updating of the cards is done either by physically recharging the card with additional rights using a charger or by replacing an outdated disposable card with a new one (p.3, l.4-8).

3) Different types of cards cause problems.

a) The user must carry several different cards used in different systems. When using the different systems, the user always needs a certain card designed for the particular system (p.3, l.11-15).

b) Actions for updating of the cards must be carried out separately for each card at different points. For example, a money card is recharged at a bank, a credit card is updated on the premises of the commercial enterprise giving the credit, a bus ticket is updated at a kiosk, and so on (p.3, l.16-24).

4) Lehmus proposes to overcome these problems by providing the SIM card with an additional interface and using the SIM card not only as a SIM card, but additionally as a smart card (p.4, l.31 – p.5, l.12). In this regard, Lehmus discloses three preferred embodiments of the proposed usage of a SIM card as a smart card (p.7, l.12-14):

a) FIG. 4a (p.9, l.5 – p.10, l.17):

Using the SIM card as a credit card.

An external remote reader sends a billing message including information about a sum to be debited to an application on the SIM card (p.9, l.13-16). The application forwards the message as an SMS to a suitable server which verifies the credit-worthiness of the subscriber and returns a response indicating whether granting or rejection of the credit (p.9, l.17 – p.10, l.2). On receipt of the response, the external card reader either prints a receipt for the payment or announces that the payment could not be made (p.10, l.6-10).

b) FIG. 4b (p.10, l.18-28):

Using the SIM card as a pre-paid card.

Different from the embodiment described above, no debiting is done for a suitable server. Instead, money is first loaded into the SIM card and then the user is debited by decreasing his/her payment tickets created beforehand on the SIM card. Again, the final step is, that the seller's card reader system is informed of the remittance.

c) FIG. 4c (p.10, l.29 – p.11, l.19):

Using the SIM card as an access card.

This embodiment comprises the two former embodiments as an alternative, if it is necessary to debit the user for the permission. The SIM card will be asked about the right of access by an external card reader. If it is necessary to debit the user for the permission (p.11, l.6-8), the SIM card will – as described in the two former embodiments – forward such a request to a suitable server (p.11, l.4-6) or decrease tickets on a prepaid card (p.11, l.8-9). Otherwise, the SIM card may respond immediately. If the SIM card has the right of access, the final step is again that the card reader will indicate this by giving a sound signal or by opening the door (p.11, l.11-15).

Thus, in all embodiments disclosed in Lehmus the final result is some reaction of an external card reader. Lehmus, however, does not disclose to allocate the use of a requested service over a radio communication network if a pre-paid account status indicates a specific value, as claimed for example in claim 27.

Claim Rejections – 35 U.S.C. §103

Claim 33 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Lehmus in view of Sivula (U.S. Patent No. 6,907,239 B1); Claims 34 and 35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lehmus in view of Capitant (U.S. Patent No. 6,976,011 B1) and Claim 36 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Lehmus in view of Capitant (U.S. Patent No. 6,976,011 B1) and further in view of Sivula (U.S. Patent No. 6,907,239 B1). The rejections are respectfully traversed for the same reasons presented in the arguments above, and for at least the following additional reasons.

Capitant "relates to a process for making a secure remote payment ... using a mobile radiotelephone." (Abstract). Sivula generally relates to "Charging for Telecommunications Download Service". Neither Capitant nor Sivula disclose allocating the use of a requested service over a radio communication network if a pre-paid account status indicates a specific value, as required by the claimed invention.

Additionally, there is no disclosure in any of the documents to the problem that resources of the radio communication network are very limited, and that it therefore might be desirable to avoid the allocation of the use of the requested service over the radio communication network. Moreover, there is no disclosure in any of the documents that the allocation of the use of the requested service over the radio communication network shall be avoided if a pre-paid account status doesn't indicate a specific value, in particular that pre-paid credit is available. The mere fact that the technologies disclosed in the cited prior art and our invention have some features in common and look at the first glace a bit similar does not render our invention obvious. Comparing two technologies in such a way is not permitted as this constitutes impermissible hindsight.

Nor may the Examiner use the instant application as a blueprint to piece together features from various references. "To reach a non-hindsight drive conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct." *In re* Kahn, 441 F.3d 977, 987 (Fed. Cir. 2006).

The Examiner fails to provide a reason why one having skill in the art would have modified the references in the manner suggested. It is of particular importance that the problems of the prior art and of our invention are completely different. The cited prior art tries to achieve a secure payment initiated from a remote system, whereas our invention seeks to save valuable resources in a radio communication network. In our invention, the payment is already achieved

and it is only checked whether there is enough money left. To the extent that this resembles pre-paid scenario disclosed in Lehmus it must not be overseen that in the pre-paid scenario, the credit is on the SIM card whereas in our invention it is on a remote service computer. The pre-paid scenario does not disclose to contact a service computer and ask for a pre-paid account status. Moreover, in the pre-paid scenario the pre-paid account on the SIM card is not used to avoid the allocation of the use of the requested service over the radio communication network if a pre-paid account on the SIM card doesn't indicate a specific value, in particular that no more pre-paid credit is available.

In view of the above, Applicants submit that this application is in condition for allowance. An indication of the same is solicited. The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing, referencing Attorney Docket No. 112740-1059.

Respectfully submitted,

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